

REMARKS:

Claims 1-36 were pending in this application. Claims 5 and 9-11 have been canceled. Claims 1-4, 6-8, 12-13, 19-20, 24, 26-27, 29, and 31-36 have been amended. No claims have been added. Therefore, claims 1-4, 6-8, and 12-36 are now pending in this application.

Support for the present claim amendments is found in the originally-filed specification, including at least paragraph 67 and original claim 6. No new matter is added.

Section 101 Rejections

Claims 1, 2, 7, 8, 12-19, 26-30, and 31-33 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Applicant respectfully disagrees with the Examiner's rejections. Reconsideration and removal of the § 101 rejections is requested in view of the remarks below.

Claims 26-33

In the Office Action, the Examiner rejects claims 26-33 as being “apparatus claims[s] [that are] just limited to a functional descriptive material consisting of software per se . . . instead of being defined as including tangible embodiments (i.e., a computer readable storage medium such as a memory device, storage medium, etc.).” Office Action at 3, paragraphs 6-7. Applicant respectfully traverses.

Claims 26 recites an “apparatus” comprising “a **logic unit** configured to implement a message converter” Claims 27-30 depend from claim 26. Claim 31 recites an “apparatus” comprising “first means for performing communication . . .” and “second means for performing protocol and data format translation” Claims 32 and 33 depend from claim 31. As discussed above, the Examiner admits that the claims are directed to “apparatus.” As such, the claims fall within one of the four categories of patentable subject matter set forth by 35 U.S.C. § 101. To this point, the MPEP instructs:

To properly determine whether a claimed invention complies with the statutory invention requirements of 35 U.S.C. 101, USPTO personnel must first identify whether the claim falls within at least one of the four enumerated categories of patentable subject matter recited in section 101 (i.e., process, machine, manufacture, or composition of matter).

MPEP 2106(IV)(B). The fact that an apparatus claim may recite process steps does not change the classification of the claim. *Id.* (“Note that an apparatus claim with process steps is not classified as a ‘hybrid’ claim; instead, it is simply an apparatus claim including functional limitations.”).

The rejection appears to improperly analyze the claims as “software per se” instead of analyzing each claim as “an apparatus claim including functional limitations” as specified by the guidance of MPEP 2106. The Examiner’s rejection appears to analyze the claims in accordance with MPEP 2106.01, which is directed to examination of computer-related matter. Even assuming *arguendo* that the apparatus claims include a computer program, the MPEP instructs:

Computer programs are often recited as part of a claim. USPTO personnel should determine whether the computer program is being claimed as part of an **otherwise statutory manufacture or machine**. In such a case, **the claim remains statutory irrespective of the fact that a computer program is included in the claim**.

MPEP 2106.01(I) (emphasis added). Accordingly, Applicant respectfully submits that the § 101 rejection of claims 26-33 is improper for at least the reasons discussed above. Reconsideration and withdrawal of the rejection is requested.

Claims 1, 2, 7, 8, and 12-19

Amendments are presented herein that are believed to address the § 101 rejections of claims 1, 2, 7, 9, and 12-19. For example, method claim 4 has been amended to recite a “translator device” executing the claimed method steps. Reconsideration and withdrawal of the rejection is respectfully requested.

Art-Based Rejections

Claims 1-36 stand rejected under 35 U.S.C. § 103 as being unpatentable over various combinations of Dorsey (U.S Patent No. 6198751), Broulik (U. S Patent No.6323881), Nackman (U.S Patent No. 4797842), Sternberg (U.S Patent No. 4290049), Netravali (U.S Patent No. 5680552), Tiemann (U.S Patent No. 4903026), O’Hagan (U.S Patent No. 6424830), and Campana (U.S Patent No. 5694428). Specifically, independent claims 12, 20, 26, 31, and 34 are rejected as being unpatentable over Dorsey in view of Nackman, and further in view of

Sternberg. As amended, independent claim 1 includes features that were rejected as being unpatentable over Dorsey in view of Broulik, Nackman, and Sternberg.¹ Applicant respectfully disagrees with the Examiner's rejections. Reconsideration and removal of the § 103 rejections is requested in view of the remarks below.

Applicant respectfully submits that the cited references fail to teach or suggest at least **“said generating includes using a . . . poly-dimensional finite state machine,”** as recited in claim 12. The Examiner admits that Dorsey does not disclose this feature, but alleges that disclosure is provided Nackman.² Office Action at 12.

Nackman does not provide any teaching or suggestion of the claimed **“said generating includes using a . . . poly-dimensional finite state machine,”** or *any* “finite state machine” for that matter. The Nackman reference appears to relate to numerical simulation methods for “automatically generating finite elements of an object” that “is defined by a geometric model.” See Nackman at col. 1, lines 9-10; col. 2, lines 42-44. The portion of Nackman cited by the Examiner discloses “[t]he invention provides a procedure for automatically generating finite elements (sometimes called a finite element mesh) from a multi-dimensional geometric model.” Nackman at col. 9, lines 4-7. It appears that the Office Action may be asserting that Nackman's disclosure of “finite elements (sometimes called a *finite element mesh*) from a multi-dimensional geometric model” teaches or discloses the “*finite state machine*” of claim 12. Applicant disagrees, and submits that Nackman's “*finite elements*” (e.g., for use in Finite Element Analysis) does not teach or suggest the “*finite state machine*” of claim 12, as that term would be understood by those of ordinary skill in the relevant art. Indeed, the only apparent commonality between the “finite element mesh” of Nackman and the “finite state machine” of claim 12 is the common term “finite.” The other cited references do not cure this deficiency.

¹ Claim 1 was rejected as being unpatentable over Dorsey in view of Broulik, and claim 6 was rejected as being unpatentable over the Dorsey, Broulik combination, in view of Nackman, and further in view of Sternberg. Office Action at 4, 12. Claim 1 has been amended to include features previously recited in claim 6. Therefore, amended claim 1 includes features that were rejected as being unpatentable over Dorsey in view of Broulik, Nackman, and Sternberg.

² Sternberg and Broulik, which appear to be directed to pattern recognition in image analysis, and web based GUI servers and methods, respectively, are not alleged to disclose the claimed “finite state machine” (much less a “*poly-dimensional* finite state machine”). Sternberg is alleged to disclose “a multi stage pipeline” Broulik is alleged to disclose “a message router”

Furthermore, Applicant submits that the Examiner has not adequately established motivation to combine Nackman with Dorsey (or any cited reference) in the suggested manner. The Examiner asserts:

It would have been obvious to the one skilled in the art at the time of the invention to combine the teaching of Dorsey, Nackman with the teaching of Sternberg to have the generating includes using a multi-stage, multi dimensional finite state machine. Because it would provide users a better method to avoid full-feature TCP handling on the proxy but still achieve live protocol translation at line-speed in a TCP compliant, TCP-friendly manner, translate a protocol connection request to another protocol connection type when receiving a protocol connection request to a particular destination address or host name, to completely automate so that no interactive assistance is required from user, minimize processing times and the cost of implementation of hardware when analyzing complex images.

Office Action at 28-29. Applicant respectfully submits that the alleged motivation to combine has no relation to the teachings of the Nackman reference. Nackman teaches that the disclosed finite element models may be used to address “problems in various fields of technology [that] require the solution of partial differential equations” such as “heat transfer, stress and vibration analysis, diffusion, fluid flow and electric and magnetic fields.” Nackman at col. 1, lines 15-19. In contrast, Dorsey is directed to a “multi-protocol packet translator” for use in communication networks. *See* Dorsey at col. 1, lines 1-8. Applicant submits that one of ordinary skill in the relevant art would not look to the numerical simulation teachings of the Nackman reference in attempting to modify the packet translator of Dorsey. In fact, Nackman does not appear to be “‘analogous prior art’ for the purpose of analyzing the obviousness of the subject matter at issue.” *Cf.* MPEP 2141.01(a)(I) (“a reference in a field different from that of applicant’s endeavor may be reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his or her invention as a whole.”).³

³ Applicant notes that similar problems exist with other references of the combinations of references asserted in the § 103 rejections. As but one example, Sternberg is appears to be directed to pattern recognition in image analysis. It is not clear to Applicant why one of ordinary skill in the art would find Sternberg’s disclosure to be relevant to Dorsey’s disclosure.

For at least the reasons stated above, Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness with respect to claim 12. (and, by extension, its dependent claims). Similar remarks apply to independent claim 1, 4, 7, 12, 20, 26, 31, and their respective dependent claims. Accordingly, Applicant respectfully requests reconsideration and removal of the present § 103 rejections.

Applicant also submits that numerous ones of the dependent claims recite further distinctions over the cited art. However, since the rejection has been shown to be unsupported for the independent claims, a further discussion of the dependent claims is not necessary at this time.⁴

⁴ Applicant notes that several assertions within the Office Action may lead to misinterpretation. For example, paragraph 38 (Office Action at 36) states “Dorsey discloses at least a portion of the memory is reprogrammable to update operation of the finite state machine.” However, as discussed above, the Examiner admits that Dorsey does not disclose a “finite state machine.” Nothing in the current response is to be taken as acquiescence to such assertions.

CONCLUSION:

Applicant respectfully submits the application is in condition for allowance, and an early notice to that effect is requested.

If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above-referenced application from becoming abandoned, Applicant hereby petitions for such extension.

The Commissioner is authorized to charge any fees that may be required, or credit any overpayment, to Meyertons, Hood, Kivlin, Kowert & Goetzl, P.C. Deposit Account No. 501505/6057-30702/EM.

Also filed herewith are the following items:

- ☐ Request for Continued Examination
- ☒ Information Disclosure Statement
- ☐ Notice of Change of Address
- ☒ Petition for Extension of Time
- ☐ Other:

Respectfully submitted,

Date: August 6, 2009

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